

REMARKS/ARGUMENTS

Claims 1-20 are pending in the present application. Although, no claims have been amended in the present response, applicants have provided a listing of the pending claims for the Examiner's convenience.

§ 112 REJECTION

Claims 1-20 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

35 U.S.C. § 112, second paragraph, states:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

(35 U.S.C. § 112, ¶2).

The Office action states:

Claim 1 recites in pream[ble] "a method for dynamically changing attributes in an embedded-SQL application" wherein the body of the claim recites "providing an option within a standard SQL statement for specifying one or more attributes of at least a declared cursor and processing the standard SQL statement to include the specific one or more attributes in at least the declared cursor." The body of the claim does not perform what is being set forth in the pream[ble]. The body of the claim does not provide an automatic way to change the attributes in the embedded SQL applica[tion]. These limitations do not provide the attributes of the declared cursor to be dynamically changed. These limitations provide an option within the standard SQL statement for the user to declare[] one or more attributes of the at least declared cursor and process the SQL statement including the specific one or more attributes in the at least the declared cursor. Applicants are advised to amend the claim to tie the preamble with the body to dynamically change attributes...

Claims 8 and 15 are system and a computer readable medium to perform the method of claim 1; therefore, they are rejected under the same reason as claim 1.

Claims 2-7, 9-14, and 16-20 are rejected under the reason as to their base claims.

(August 24, 2005 Office action, pgs. 2-3).

Applicants respectfully disagree. There is no requirement under 35 U.S.C. § 112, second paragraph, that the body of the claim perform what is set forth in the preamble. MPEP § 2106 specifically states:

[T]he applicant need not explicitly recite in the claims every feature of the invention. . . . In fact, it is preferable for claims to be drafted in a form that emphasizes what the applicant has invented (i.e., what is new rather than old). *In re Dossel*, 115 F.3d 942, 946, 42 USPQ2d 1881, 1884 (Fed. Cir. 1997).

(MPEP § 2106, 8th ed. rev. 2).

In addition, MPEP § 2111.02 specifies:

If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999).

(MPEP § 2111.02, 8th ed., rev. 2). Since the body of claims 1-20 fully and intrinsically set forth all of the limitations of the claimed invention, the preamble cannot be considered a limitation.

Accordingly, based at least on the above reasons, applicants respectfully submit that claims 1-20 do particularly point out and distinctly claim the subject matter which the applicants regard as their invention. Therefore, withdrawal of the rejection is respectfully requested.

CONCLUSION

On the basis of the above remarks, reconsideration and allowance of the claims is believed to be warranted and such action is respectfully requested. If the Examiner has any questions or comments, the Examiner is respectfully requested to contact the undersigned at the number listed below.

Respectfully submitted,
SAWYER LAW GROUP LLP

Dated: November 10, 2005



Erin C. Ming
Attorney for Applicant(s)
Reg. No. 47,797
(650) 475-1449